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IN THE

Supreme Court of the United States

October Term, 1948.

No. 372.

LEROY J. LEISHMAN,

Petitioner,

vs.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT
CORPORATION,

Respondents.

PETITION FOR REHEARING OF ORDER ON
PETITION FOR WRIT OF CERTIORARI
AND BRIEF IN SUPPORT THEREOF.

LEROY J. LEISHMAN,

2921 Greenfield Avenue, Los Angeles 34,

Petitioner, in Propria Persona.



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**PETITION FOR REHEARING OF ORDER ON
PETITION FOR WRIT OF CERTIORARI.**

Brief Statement of Intervening Circumstances.

The original petition for a writ of certiorari herein was filed because of a conflict between the decision of the Court of Appeals for the Ninth Circuit herein [R. Vol. III, pp. 258 *et seq.*] and a decision of the U. S. District Court for the Western District of Oklahoma in the unreported case of *Leishman v. The Richards and Conover Company*, Civil Action No. 2155.

The said district court within the Tenth Circuit ruled that the claims here at issue were "clearly valid and clearly infringed", and the Court of Appeals for the Ninth Circuit upheld a *summary judgment* of the U. S. District Court for the Southern District of California on

the single ground that the same devices involved in the Oklahoma action did *not* infringe the said claims.

When the petition for a writ of certiorari was originally filed, the Oklahoma decision was on appeal before the Court of Appeals for the Tenth Circuit, and although the hearing therein had already been held the decision had not yet been rendered. The petition requested that action thereon be upheld pending the decision of the latter Appellate Court. On November 15, 1948, the said Court of Appeals for the Tenth Circuit rendered its opinion, reversing the lower court on the single issue of validity. On December 13, 1948, this Honorable Supreme Court denied the petition for a writ of certiorari. Six days later, on December 19, 1948, the Court of Appeals for the Tenth Circuit granted a rehearing, and on December 24, 1948, Mr. Justice Douglas extended the time for filing a petition for rehearing of the petition for a writ of certiorari until fifteen days following the anticipated new decision of the Court of Appeals for the Tenth Circuit. The said anticipated new decision was rendered on January 20, 1949. In the meantime, this Honorable Court has rendered an opinion in the case of *Jungersen v. Ostby and Barton Company, et al.*; *Ostby and Barton, et al. v. Jungersen*; *Jungersen v. Baden, et al.*, in which certiorari was granted in a situation very closely paralleling the situation that now prevails in the instant case.

The latter decision of this Honorable Court and the two aforementioned decisions of the Court of Appeals for the Tenth Circuit were all three rendered since the original petition for a writ of certiorari was filed herein, and these decisions have so altered the questions presented and the reasons then relied upon for allowance of the writ that the original questions and reasons have now been largely

superseded. Moreover, the changed status now makes other grounds that could previously have been presented have greater relevance, and they are consequently presented here for the first time. Because of these various changes, it is believed that the merits of this petition may be appraised more readily if the case is re-stated as it now appears.

Summary Statement of the Case as It Now Stands.

The reissue patent here involved is a simple one having a specification of only three columns. Yet the patentee-petitioner has been unable in ten years of litigation to have the issues of validity and infringement authoritatively adjudicated. The same five of its claims have been the subject of four infringement suits—two of them filed under the Declaratory Judgment Act by manufacturers who have made nine million push button tuners for radio sets embodying the combination set forth in the claims.

The history of the litigation has been one of piecemeal adjudications and harassment by manufacturers who seek to appropriate the teachings of the patent.

The merits of the present petition and the nature of the present case can best be seen if the suit is considered in its relationship to the other three actions.

The five claims that have been involved in all this litigation cover the features of the invention that make a push button radio tuner easy to adjust or "set" so that it will subsequently tune in the desired stations accurately. In prior art tuners, in order to achieve the necessary ease of adjustment, it had been necessary to include extra mechanism to prevent the parts of the tuner from moving during the adjusting process.

The first suit involving these five claims was that of *Leishman v. Associated Wholesale Electric Company*, 36 Fed. Supp. 804, in which the trial court held the claims invalid as lacking invention but stated in the opinion (p. 806):

“* * * But it cannot be seriously denied that the accused device uses the rotatable rocker, adjustable tappet and when brought to rest the two parts are coaxial—the essential elements contained in the plaintiff’s structure.”

The District Court thus recognized the presence of infringement, but failed to make any specific ruling or finding thereon.

Petitioner appealed from the lower court’s holding of invalidity in the *Associated* case, but the first action of the Court of Appeals for the Ninth Circuit, in an opinion written by Judge Mathews, was to dismiss the appeal on the ground that it had been taken too late. This Honorable Court, in an opinion interpreting Rule 52b, unanimously held that the appeal was timely and that the Appellate Court’s reasoning was “artificial and untenable.” (318 U. S. 203.) The Court of Appeals, in an opinion delivered by Judge Mathews, then wiped out the lower court’s holding of invalidity (137 F. 2d 722), but held that infringement had been avoided by operating the combination by means of a plunger instead of a lever. Certiorari was denied December 6, 1943.

Inasmuch as this Honorable Court has said in Rule 38(5b) and elsewhere that it will review patent cases when a conflict develops between circuit courts of appeals, petitioner then undertook to develop such a conflict by filing the suit mentioned in the first paragraph hereof

against The Richards and Conover Company (Civil Action No. 2155) in the U. S. District Court for the Western District of Oklahoma, alleging infringement by push button radio tuners that were patentwise the same as those accused in the Ninth Circuit case of *Leishman v. Associated Wholesale Electric Company, supra*, in which it was held that the substitution of plungers for levers avoided infringement.

The manufacturers of the devices involved in the Oklahoma action then endeavored to present petitioner from obtaining an independent adjudication outside the Ninth Circuit, and these manufacturers accordingly filed the instant suit under the Declaratory Judgment Act seeking an injunction against the Oklahoma proceedings, and a summary judgment of non-infringement was requested on the ground that the earlier decision in the *Associated* case, *supra*, although not *res adjudicata*, was nevertheless *stare decisis*.

Before the lower court acted in the instant summary judgment proceeding, the trial of the *Richards and Conover* case was held in the U. S. District Court for the Western District of Oklahoma, where the court held the claims here at issue *clearly valid and clearly infringed* and stated that petitioner's tuner could be operated either by plungers or levers, these operating members being well-known mechanical equivalents for such purposes. This judgment was thus in direct conflict with that of the Court of Appeals for the Ninth Circuit in the *Associated* case.

Subsequent to the entry of the judgment in the Oklahoma suit, the lower court granted the motion for summary judgment of *non-infringement* in the instant action

on the basis that the *Associated* decision was controlling. Despite a mass of new evidence in the present record to show that plungers and levers were well known in the prior art as alternative means for operating automatic push button tuners, the Court of Appeals for the Ninth Circuit, in a decision written by Judge Mathews, nevertheless affirmed the summary judgment of non-infringement and reaffirmed its decision in the *Associated* case. The petition for a writ of certiorari herein was then filed within the time period as extended by Mr. Justice Douglas, this petition setting forth the conflict with the District Court in the Tenth Circuit.

Subsequently, the Court of Appeals for the Tenth Circuit reversed the U. S. District Court for the Western District of Oklahoma on the issue of validity only (79 U. S. P. Q. 316); and while the issue of infringement was thus a moot question as far as the appellate court was concerned, the latter court nevertheless went out of its way to express disagreement with the *Associated* decision and to refer to a paragraph in Walker on Patents supporting the lower court's views on infringement, and the appellate court cited one of its own prior decisions where it had decided the specific question that a member that "may be moved back and forth horizontally," as does the plunger in this case, is the equivalent of one that may be moved "on a hinged joint," as does the operating lever shown in the patent here in suit.

The decision of the Court of Appeals for the Tenth Circuit thus created an over-all situation in which the claims here at issue are valid but not infringed by respondents' devices in the Ninth Circuit because these devices are operated by plungers instead of levers as shown in the patent, whereas in the Tenth Circuit the claims are

invalid but would otherwise be infringed by respondent's devices. Petitioner thus obtained the sought-for conflict between the circuits on the equivalency of plungers and levers, the only point in dispute on the issue of infringement. But an additional conflict developed on the issue of validity, because the Tenth Circuit's ruling that the claims are invalid for want of invention is in conflict with the situation in the Ninth Circuit where the appellate court in the *Associated* case, *supra*, wiped out the lower court's holding that the claims were invalid for want of invention.

Immediately after the Court of Appeals for the Tenth Circuit rendered the aforementioned decision reversing the lower court on the issue of validity and supporting the lower court's views on infringement, respondents herein filed a brief opposing the issuance of a writ of certiorari; and respondents' brief (p. 2) erroneously informed this Honorable Court:

"There is *no* conflict between the decision herein and the decision of any other court. The United States District Court for the Western District of Oklahoma had held the patent valid and infringed in *The Richards and Conover case, supra*, but since the filing of the petition for writ of certiorari in the instant case, the Court of Appeals for the Tenth Circuit, on November 15, 1948, *reversed* such holding and held the patent invalid for lack of invention and as anticipated by the prior art." (Emphasis added.)

Petitioner filed a Reply Brief pointing out that the facts were not as indicated in Respondent's Brief; but the said Reply Brief was filed only a few days before the petition was formally denied, and the Reply Brief may thus have

arrived too late for the erroneous information to be corrected in time for this Honorable Court's consideration.

Inasmuch as it has been the practice of this Honorable Court to resolve the conflicting views of courts of appeals, petitioner believed that his petition may have been denied because both courts of appeals had held against him, although on totally different grounds. He therefore secured an extension of time for filing this petition for rehearing, believing that the Court of Appeals for the Tenth Circuit might reverse its own ruling of invalidity following the rehearing which said appellate court had already set for January 4, 1949. But the fact that the said appellate court, in its new decision of January 20, 1949, did not reverse its own ruling of invalidity, now seems immaterial, for this Honorable Court has in the meantime rendered an opinion where certiorari was granted to resolve a conflict between Courts of Appeals that had *both* held *against* the petitioner. The said opinion of this Honorable Court was rendered in *Jungersen v. Ostby and Barton Company et al.*; *Ostby and Barton Company et al. v. Jungersen*; *Jungersen v. Baden et al.*, decided January 3, 1949. In one of the *Jungersen* cases, the Court of Appeals for the Second Circuit affirmed the lower court which held all the claims invalid; and in another of the *Jungersen* cases, the Court of Appeals for the Third Circuit affirmed a decision holding only a part of the claims invalid but the rest not infringed. Although Jungersen thus lost both suits, this Honorable Court nevertheless said:

“* * * We granted certiorari in both cases in order to settle the conflict. 334 U. S. 835.”

The present petitioner is in a more favorable patent situation than Jungersen, because only in the Tenth Circuit is there any holding of invalidity against the patent and only in the Ninth Circuit is there any holding that the claims are not infringed. The holding of non-infringement in the instant case is in conflict with the findings of infringement by the U. S. District Court for the Western District of Oklahoma which the Court of Appeals for the Tenth Circuit has approved and supported by reference to one of its prior decisions and a paragraph in Walker on Patents elucidating the doctrine of equivalents.

The specific wording of the decisions setting up the conflict are quoted in the argument in the brief following this petition.

Although a petition for a writ of certiorari will be filed in the Tenth Circuit case on the issue of validity as soon as the clerk of the court can prepare the record for transmission to this Honorable Supreme Court, the holding of invalidity in that case is not *res adjudicata* with respect to the different litigants in the present action. There has been no adjudication of the issue of validity in this case, and petitioner is entitled to have the conflict reviewed on the issue of infringement irrespective of the holding of invalidity in the other action, so that the remaining issues herein may be determined by the courts below.

Should this Honorable Court nevertheless feel that the two cases should be reviewed at the same time, it is respectfully requested that action on this petition for a re-

hearing of the original petition be suspended until receipt of the petition for a writ of certiorari in the Tenth Circuit case of *The Richards and Conover Company v. LeRoy J. Leishman*, Appeal No. 3577.

Jurisdiction.

Matters relating to the subject of jurisdiction were fully set forth in the original petition. As previously mentioned, the time for filing this petition for rehearing under rule 33(2) was extended by Mr. Justice Douglas on December 24, 1948, until fifteen days following the rendering of the new decision of the Court of Appeals for the Tenth Circuit in the *Richards and Conover* case, *supra*. The said decision, affirming the original opinion of that appellate court, was rendered on January 20, 1949.

The Questions Presented.

Inasmuch as the issue of infringement is the only issue that has been adjudicated in the present case, only two questions need be decided to resolve the conflict. These questions are:

1. Is it necessary that the operating member be considered at all when determining infringement of claims 7 and 8, in which no operating member is included as an element?
2. Can infringement of claims 9, 10 and 11 be avoided if the "manually movable operating member" or "manually movable operating means" called for in these claims, is a plunger as in the accused devices instead of a lever as shown in the patent?

Reasons Relied Upon for Allowances of the Writ.

1. The opinion of the Court of Appeals for the Ninth Circuit in the instant case is in conflict with that of the Court of Appeals for the Tenth Circuit in the case of *The Richards and Conover Company v. LeRoy J. Leishman*.

2. The resolution of this controversy is of importance to the radio industry because it involves the push button radio tuners now provided as factory equipment in most automobiles. This type of tuning has largely replaced "manual" tuning, enabling the motorist to tune his radio receiver without taking his eyes from the road. Such tuners are now installed as factory equipment in all current models of American automobiles with the exception of Packard, Studebaker and certain models in the Chrysler line. This same patent was recently the subject of another declaratory judgment suit brought in the Ninth Circuit by General Motors Corporation to have the issues of validity and infringement adjudicated. The final brief before the district court in the General Motors case will be filed within a few days. A decision by this Honorable Court herein will thus benefit the radio industry as well as most of the automobile industry.

Prayer for the Issuance of the Writ.

Wherefore, your petitioner prays that a writ of certiorari issue under the seal of this Court, directed to the Court of Appeals for the Ninth Circuit, commanding said court to certify and send to this court a full and complete transcript of the record of the proceedings of the said court had in the case numbered and entitled Docket No. 11652, LeRoy J. Leishman, appellant, v. Radio Condenser Company and General Instrument Corporation, appellees, to the end that this cause may be reviewed and determined by this Court as provided by the statutes of the United States; and that the judgment herein of said Court of Appeals for the Ninth Circuit be reversed by the court, and for such other relief as to this court may seem proper.

Dated this 2nd day of February, 1949.

LEROY J. LEISHMAN,
Petitioner, in Propria Persona.

Certificate.

This petition is in my judgment well founded, and is restricted to grounds specified by Rule 33(2), and is not interposed for purposes of delay.

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Respondents.

**Brief in Support of Petition for Rehearing of Order on
Petition for Writ of Certiorari.**

I.

Publication of Opinions of Lower Courts.

The opinion in the District Court was an unreported memorandum opinion, but the findings of fact may be found in Vol. I of the record, beginning on page 86.

The opinion in the Court of Appeals for the Ninth Circuit [R. Vol. III, p. 285 *et seq.*] is reported in 167 F. 2d 890.

II.

Basis of Jurisdiction.

The judgment was rendered on a motion for summary judgment of the single issue of infringement in an action brought under the Declaratory Judgment Act (Sec. 274-D of the Judicial Code, 28 U. S. C. par. 40 (before the recent revisions)) and patent statutes of the United States.

Jurisdiction of this Court is invoked under Section 240 of the Judicial Code, corresponding to Title 28, U. S. C. A., Paragraph 1254; and also under Rule 38(5b) of the Rules of the Supreme Court. The rehearing of the petition is requested under rule 33(2) of the rules of this Court.

III.

Statement of the Case.

This has already been stated in the foregoing petition under the heading: Brief Statement of Intervening Circumstances, and Summary Statement of the Case as It Now Stands. These statements are hereby adopted and made a part of this brief.

IV.

Specification of Errors.

1. The Court of Appeals for the Ninth Circuit erred in holding that respondent's tuners do not infringe claims 7 to 11 of patent No. Re. 20,827.
2. The Court of Appeals for the Ninth Circuit erred in holding that a plunger is not the equivalent of a lever in the operation of the combinations set forth in the claims here at issue.
3. Inasmuch as original claim 5 included no operating member at all, and since plungers and levers are equivalents anyway, the Court of Appeals for the Ninth Circuit erred in holding that the reissue claims are not for the same invention as the original claims unless they include levers.

V.

ARGUMENT.

Rule 38(5b) of this Honorable Court provides that the court will resolve a conflict between the courts of appeals of different circuits in patent cases. Such a conflict was set up by the action of the Court of Appeals for the Ninth Circuit in affirming and adopting its previous decision in the *Associated* case, and by the action of the Court of Appeals for the Tenth Circuit in disagreeing with the said *Associated* decision and in supporting the U. S. District Court for the Western District of Oklahoma in its findings that the plungers of the accused tuners are equivalents of the levers shown in the patent.

In *Leishman v. Associated Wholesale Electric Co.*, 137 F. 2d 722, 727, the Court of Appeals for the Ninth Circuit said: “* * * the plungers and the levers are not equivalents.”

In its decision in the instant case, the Court of Appeals for the Ninth Circuit said [R. Vol. III, p. 263]:

“Leishman contends that the California court erred in following our decisions in the *Associated* case. There is no merit in this contention. Our decision has not been reversed or overruled. The California court was not at liberty to overrule it. We could overrule it if we thought it was wrong, but, after reconsidering it, we think it was right and now reaffirm it.”

The Court of Appeals for the Tenth Circuit, in speaking of the Ninth Circuit's *Associated* decision said (79 U. S. P. Q. 316 at 319):

“There, as here, the alleged infringing device employs only one rocker and one set of corresponding

tappets, and the tappets are mounted on and moved by plungers, not levers.

"However, claims 7 to 11, inclusive, embrace a single rocker and corresponding adjustable tappets mounted on pivots, means for moving each tappet so one of its sides engages one arm of the rocker and rotates the rocker until the other side of the tappet engages the other arm of the rocker, and *they do not specifically embrace a lever means for carrying and moving the tappets; and we are unwilling to rest our decision on the narrow ground that the lever in the device of the patent in suit and the plunger in the accused device are not mechanical equivalents.*" (Emphasis added.)

As already mentioned in the statement of the case in the foregoing petition, footnote 3 cited a previous decision of the Court of Appeals for the Tenth Circuit and also referred to a paragraph in Walker. The Tenth Circuit reference was *Steiner Sales Co. v. Schwartz Sales Co.*, 98 F. 2d 999 at 1012, where the court decided the specific point at issue here and concluded that a member that slides horizontally, like a plunger, is the equivalent of one that is pivoted, like a lever.

Section 468 in Walker, Deller's Edition, Vol. 3, p. 1706, to which reference is also made in footnote 3, deals with tests of equivalency, and says:

"Function must be performed in substantially the same way by an alleged equivalent, as by the thing of which it is alleged to be an equivalent, in order to constitute it such. (Citing decisions.) This substantial sameness of way is not necessarily an identity of

merit (citing decisions), nor a theoretical scientific sameness. (*Gordon v. Warder*, 150 U. S. 47, 52 (1893).) In a purely scientific sense, a screw always performs its function in a substantially different way from a lever, and in substantially the same way as a wedge. Screws and wedges are equally inclined planes, while a lever is an entirely different elementary power. But screws and levers can practically be substituted for each other in a larger number of machines than screws and wedges can be similarly substituted. When a lever and a screw can be interchanged and still perform the same function with a result that is beneficially the same, they are said to perform the same function in substantially the same way. (*Turrell v. Spaeth*, 3 Bann. & Ard. 458, Fed. Case. No. 14,269 (1878).) Levers and springs are also used interchangeably in the arts (*Gould Coupler Co. v. Pratt*, 70 Fed. 622, 627 (1895)), and levers of a different class constitute examples of equivalency."

These remarks and citations of the Court of Appeals for the Tenth Circuit thoroughly supported the district court in Oklahoma which made the following findings on the equivalency of the plunger in the accused devices and the lever shown in the patent [R. Vol. I, p. 55]:

"11. The tappet or positioning element described in plaintiff's reissue patent No. 20,827 may be mounted either on a lever or a plunger to move the tappet, since a lever and a plunger perform their functions in the same way and are mechanical equivalents.

"12. The finding 11 is based not only upon the evidence offered on behalf of plaintiff, but also upon the direct testimony of defendant's expert, Dr. Spotts, who testified to the effect that the substitution of plungers for levers is a simple one in the combination covered by claims 7, 8, 9, 10 and 11 of said re-issue patent."

These findings were not reversed or disturbed, and consequently are the law in the Tenth Circuit.

The conflict between the Courts of Appeals is thus definite and direct, and the requirements of rule 38(5b) are thus fully met.

Petitioner, having relied upon this rule when he instituted and carried through the proceedings in the Tenth Circuit, is entitled to have the instant decision reviewed by this Honorable Court now that he has succeeded in meeting the requirements of the rule.

If the original denial of the petition was based upon the fact that petitioner won neither of the suits involved in this conflict, such ground for denial should no longer apply, because this Honorable Court in the *Jungersen* cases, *supra*, granted certiorari when both appellate courts had held against the petitioner.

Moreover, the holding of invalidity in the Tenth Circuit case is not in any way binding in the present Ninth Circuit case where the parties are different. If the Court of Appeals for the Ninth Circuit is wrong in its holding that plungers and levers are not equivalents, then a denial of certiorari herein would deprive petitioner of the right to have the issue of validity independently determined between the present parties in the Ninth Circuit. That he

has such a right, is clear from this Honorable Court's decision in *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 56 S. Ct. 645 at 648, where the court said:

"We conclude that neither the rules of the common law applicable to successive litigations concerning the same subject-matter, nor the disclaimer statute, precludes relitigation of the validity of a patent claim previously held invalid in a suit against a different defendant."

If the holding of invalidity in the Tenth Circuit should prevent this Honorable Court from resolving the conflict on infringement between the circuits, then the holding of invalidity in the Tenth Circuit will definitely act to preclude relitigation of that issue between the present parties within the Ninth Circuit.

Conclusion.

It is therefore respectfully submitted that this case is one calling for this Court to resolve the conflicts herein set forth and to exercise its supervisory powers by granting a writ of certiorari and thereafter reviewing and reversing the decision of the court below.

LEROY J. LEISHMAN,

Petitioner, in Propria Persona.